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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,190	03/21/2007	Mitsuhiro Ayaki	SHIGA3.010APC	1681

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EXAMINER

O HERN, BRENT T

ART UNIT	PAPER NUMBER
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1794

NOTIFICATION DATE	DELIVERY MODE
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11/12/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
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Office Action Summary	Application No. 10/582,190	Applicant(s) AYAKI ET AL.	
	Examiner Brent T. O'Hern	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/8/2006, 3/14/2008, 8/14/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “wherein at least a portion of a middle layer of the multilayer paper which corresponds to a position for embedding the IC chip is formed without attaching a sheet of raw material to the portion or discontinuously attaching the sheet of raw material” in claim 8, lines 1-4 is vague and indefinite since it is unclear whether the claim is referring to the method of making the sheet or the sheet and if the language is referring to the sheet then it is unclear whether a portion of material is attached to the IC chip and which material is the raw material. Furthermore, it is unclear what structural limitations are set forth by the “discontinuously attaching” language. The claim is substantially unclear.

Clarification and/or correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-7 and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujiki et al. (WO 03/027950) with evidence by Fujiki et al. (US 2004/0262404) which is interpreted as the English language equivalent of Fujiki et al. (WO 03/027950).

Fujiki ('950) teaches a multilayer tape/sheet with a built-in IC chip used for a sheet comprising a tape body with multiple layers including a tape body, with a part or all of the IC chip being embedded in the tape body, with the IC chip being fixed to the tape body by a resin, which is inserted into the sheet-like material (*See FIGs 1-4 and paras. 24-26, 56-58 and 97 where embedded non-exposed element #20 can be an IC module #30 with IC chip #27 embedded within the multilayer tape/film #1 which is formable into a baggage tag #10 containing paper #12, resin adhesive #16, plastic resin film #13 and plastic resin protection sheet #17 and the laminate/tape being exposed at the outer surfaces/sides.*).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiki et al. (WO 03/027950) with evidence by Fujiki et al. (US 2004/0262404) which is interpreted as the English language equivalent of Fujiki et al. (WO 03/027950).

Fujiki ('950) teaches the tape/sheet discussed above, however, fails to expressly disclose wherein at least a portion of a middle layer of the multilayer paper which corresponds to a position for embedding the IC chip is formed without attaching a sheet of raw material to the portion or discontinuously attaching the sheet of raw material.

It is firstly noted as discussed above that this claim is not clear and thus not very easy to determine what structural limitations are being set forth.

However, Fujiki ('950) teaches middle layers #15, #10, #14 and #13 as illustrated in FIG-2 that are not directly attached to element #20. Furthermore IC chip #27 is separated from the edges of #30 as illustrated in FIG-3 for the purpose of providing a baggage tag that is substantially free from the problems associated with printing (See *Abstract and paras. 57-58.*).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time Applicant's invention was made to provide sheets and an IC chip with the above configuration in order to provide a baggage tag that is substantially free from the problems associated with printing.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brent T. O'Hern whose telephone number is (571)272-0496. The examiner can normally be reached on Monday-Thursday, 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Tarazano can be reached on (571) 272-1515. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/BTO/

Brent T O'Hern

Examiner, Art Unit 1794

November 3, 2008

/Elizabeth M. Cole/

Primary Examiner, Art Unit 1794